

REMARKS

Claims 1-20 remain pending in this application. Claims 1, 5, 8, 9, 11, 14, 15 and 17 are independent. Claims 1, 8, 9 and 15, have been amended, no claims have been added or canceled by this Amendment.

No new matter is involved with any claim amendment as support may be found throughout the originally-filed disclosure.

Unpatentability Rejection over Salmela et al. in View of Jarett et al.

Withdrawal of the rejection of claims 1-4, 8-10 and 15-16 under 35 U.S.C. §103(a) as allegedly being unpatentable over Salmela et al (US 6,516,193) in view of Jarett et al. (US 5,911,120) is requested. The Examiner has failed to make a *prima facie* case of unpatentability, particularly in light of the minor clarifying amendments made to independent claims 1, 8, 9, and 15.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.¹ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.² The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held "[t]o facilitate review, this analysis should be made explicit."³ "[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."⁴

¹ See MPEP §2143.

² *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

³ *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (see p. 14).

⁴ See *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Discussion of Applicant's Disclosure

By way of background, various embodiments of Applicants' disclosure is directed to a method, radio system, and subscriber network element used to determine the home area of a subscriber terminal where the subscriber terminal measures the strengths of signals received from different base stations, and stores the measurement results in a memory. In the method, a location updating message is received from the subscriber terminal. In order that the home area can be rapidly and efficiently determined, a command is transmitted to the subscriber terminal after the location updating message has been received, so that the stored measurement results are transmitted. The measurement results are received from the subscriber terminal, and then base stations with the greatest signal strengths are identified on the basis of the measurement results. The home area of the subscriber terminal is then determined such that it includes at least one of the identified base stations.

Discussion of Salmela et al.

According to the Abstract, Salmela et al. ("Salmela") is purportedly directed to a method and arrangement for controlling the local operation of a mobile station wherein a mobile station specific group of special cells is formed from selected network cells. Information concerning a group of special cells is transmitted to the mobile station via a radio path, and the operation the mobile station is controlled on the basis of the group of special cells.

As admitted by the Examiner in the Official Action at page 3, second paragraph, for example, Salmela fails to teach or suggest a solution wherein a transceiver is arranged to transmit measurement results stored in the memory to other parts of the system in response to a command received by the subscriber terminal.

Discussion of Jarrett al.

In an effort to overcome the admitted deficiencies of Salmela, the Examiner alleges that Jarrett et al. ("Jarrett") makes up for the missing limitations of independent claims 1, 8, 9, and 15. Applicants respectfully traverse this characterization of Jarrett.

According to the Abstract, Jarett is purportedly directed to a wireless communication system having mobile station this that establish a communication link to the base station without using a landline or regional cellular network, and without a call in progress. In Jarett, a mobile station communicates both with a cellular network, by which it is assigned a mobile identification number, and to a cordless cellular base station utilizing the same cellular frequency range and communication protocol. The cordless cellular base station acts as a conduit between the mobile station and the Public Switched Telephone Network ("PSTN"). When the mobile station comes within range of a cordless cellular base station, it deregisters automatically from the cellular network and registers with the cordless cellular base station. Once the mobile station is communicating with the cordless cellular base station, the cordless cellular base station communicates with the cellular network to instruct the cellular network to route all calls for the mobile identification number to the cordless cellular-base station's landline number. Once the mobile station is registered with a regional cell, calls to the mobile stations identification number are directly ratted by the cellular network to the mobile station.

Jarett is silent on teaching that measurement results stored in a memory of a mobile station are transmitted to other parts of the system. Indeed, the Examiner alleges that col. 13, line 3-col. 14, line 12 of Jarett provides a teaching or suggestion of transceiving means arranged to transmit measurement results stored in the memory to other parts of the system in response to a predetermined command received by the subscriber terminal. Applicants respectfully traverse this interpretation of Jarett.

A closer reading of the cited portion of Jarett actually discloses that the mobile station maintains in its memory a table 78 with information about the three cordless cellular base stations with which it has previously registered (see col. 13, lines 38-43). However, Jarett does not, in any way, suggest that this table should be sent to a base station. Instead Jarett only suggests that the user can enter a keystroke procedure on the mobile station in order to change the "primary" cordless base station in this table to be the one currently in use (see col. 13, lines 55-60).

In addition, Applicants point out that the table shown in FIG. 6 of Jarett does not contain *any* measurement results, but only information about the Country Code (CC), System Operating Code (SOC), Residential System ID (RS ID), Operating and backup-up channels (f0-f3), System

Identifier (SID), and Public-Service Profile (PSP₀-PSP₃), as explained at col. 14, lines 13-68, and col. 15, lines 15-23.

Thus, Applicants submit that not even a combination of Salmela with Jarett would lead a person of ordinary skill in the art to a solution where a transceiver of a subscriber terminal is arranged to transmit measurement results stored in the memory to other parts of the system in response to a predetermined command received by the subscriber terminal, as variously claimed.

However, in order to further illuminate the already clear distinctions between the applied art and the rejected independent claims, independent claims 1, 8, 9, and 15 have been amended to variously recite that the command in question is transmitted *from a base station* to the subscriber terminal, a technique that is clearly not taught or suggested by any of the applied art, either alone or in combination.

Specific Deficiencies of the Applied Art

The applied art, either alone or in combination, does not disclose, teach or suggest a method of determining a home area for a subscriber terminal in a radio system wherein the method includes, *inter alia*, "...**transmitting, from a base station, a command to the subscriber terminal after the location updating message has been received, wherein the command is to transmit the measurement results stored in the memory of the subscriber terminal**"; receiving the measurement results from the subscriber terminal; identifying the base stations with the greatest signal strengths at least partially based on the measurement results; and determining the home area of the subscriber terminal such that the home area includes at least one of the identified base stations ", as recited in independent claim 1, as amended (***emphasis*** added).

Further, the applied art, either alone or in combination, does not disclose, teach or suggest a subscriber network element that includes, *inter alia*, "...means for transmitting, **by a base station**, a command to a particular subscriber terminal which transmitted the location updating message after the detection of the location updating message, wherein the command is to transmit the **measurement results stored in the memory** of the particular subscriber terminal...", as recited in independent claim 8, as amended (***emphasis*** added).

Still further, the applied art, either alone or in combination, does not disclose, teach or suggest a subscriber terminal of a radio system which includes, *inter alia*, "...transceiving means for setting up a communication link via a radio path to other parts of the system...wherein the transceiving means are arranged to transmit ***the measurement results stored in the memory*** to the other parts of the system in response to a predetermined ***command received from a base station*** by the subscriber terminal", as recited in independent claim 9, as amended (*emphasis added*).

Finally, the applied art, either alone or in combination, does not disclose, teach or suggest a subscriber terminal of a radio system that includes, *inter alia*, "...a transceiving unit configured to set up a communication link via a radio path to other parts of the system and configured to ***transmit measurement results stored in a memory*** to the other parts of the system in response to a predetermined ***command received from a base station*** by the subscriber terminal...", as recited in independent claim 15, as amended (*emphasis added*).

Accordingly, since the applied art does not teach or suggest all the claimed limitations, reconsideration and allowance of independent claims 1, 8, 9, and 15 are respectfully requested. In addition, dependent claims 2-4, 10, and 16 variously and ultimately depend from these allowable independent claims, and are submitted as being patentable at least on that basis, without further recourse to the patentable features recited therein.

Allowable Subject Matter

Applicants note with appreciation the indication that claims 5-7 and 11-20 are allowed. It appears that there may be a minor administrative error in the Office Action in that claims 15-16 have been rejected as being unpatentable over the combination of Salmela and Jarrett, as discussed above. Applicants assume that the allowed claims correctly include claims 5-7, 11-14, and 17-20.

Conclusion

All rejections having been addressed, Applicant submits that each of pending claims 1-20 in the present application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the Undersigned Attorney is available at the telephone number indicated below.

Although no fees are believed to be due, for any fees that are due during the pendency of this application, please charge Deposit Account Number 03-3975 from which the Undersigned Attorney is authorized to draw. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Date: September 17, 2007

Respectfully submitted,

Electronic Signature: /Larry J. Hume/

Larry J. Hume

Registration No.: 44,163

PILLSBURY WINTHROP SHAW PITTMAN LLP

P.O. Box 10500

McLean, VA 22102

(703) 770-7900 (switchboard)

(703) 770-7981 (direct)

(703) 770-7901 (fax)

e-mail: Larry.Hume@pillsburylaw.com

Attorney for Applicant